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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,171	03/05/1999	LESLIE STROH	STROH	2689

545 7590 09/15/2004
ANTHONY H. HANDAL
KIRKPATRICK & LOCKHART, LLP
599 LEXINGTON AVENUE
31ST FLOOR
NEW YORK, NY 10022-6030

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	09/264,171		STROH, LESLIE	
	Examiner		Art Unit	
	Ella Colbert		3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-80,82-87 and 92-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 35-80,82-87 and 92-101 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 35-80, 82-87, and 92-101 are pending in this communication filed 06/07/04 entered as Election and Response Under 35 USC 132 and 37 CFR 1.111..
2. The previous Election/Restriction Requirement is hereby withdrawn in view of a new ground(s) of rejection as set forth here below and addressed in the Response to Arguments section of this office action.

Election/Restrictions

3. Election to one of the following inventions is required under 35 U.S.C. 121.

Group I. Claims 35-80 and 92-101, drawn to a method for a payment draft, a traded product, and a pro-forma invoice, classified in class 705, subclass 37.

Group II. Claims 82-87, drawn to an electronic printed or written bill of exchange document and a manufactured traded product, classified in class 705, subclass 80.
4. Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as the buyer providing an event –activated, latent payment draft, a traded product, the buyer accepting the payment draft, the buyer and seller commencing a payment term, delivery of the traded product, and a pro-forma invoice. Invention Group II has separate utility such as an electronic printed or written bill of exchange document, a negotiable draft, and a manufactured traded product. See MPEP § 806.05(d).

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as the buyer providing an event –activated, latent payment draft, a traded product, the buyer accepting the payment draft, the buyer and seller commencing a payment term, delivery of the traded product, and a pro-forma invoice. The invention in Group II has separate utility such as an electronic printed or written bill of exchange document, a negotiable draft, and a manufactured traded product. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and the search for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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9. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Response to Arguments

10. Applicant's arguments filed 06/07/04 have been fully considered but they are not persuasive.

Issue no. 1: Applicant Argues: Applicant notes that rule 37 CFR 1.72 regarding the abstract was revised September 8, 2000, eighteen months after the present application was filed, and may not be applicable in its revised form has been considered. Response: According the Examiner's instructions and to the printing process, all abstracts submitted whether they were submitted prior to September 8, 2000 or after September 8, 2000 are supposed to contain no more than 150 words.

Issue no. 2: Applicant argues: Applicant's arguments are not moot and should be considered and all pending claims should be allowed since there were no new grounds of rejection in the latest Office action. Response: Applicant's application has been assigned to another Examiner (the present Examiner) and the application is considered and treated as a new application. The election/restriction requirement by the presently assigned Examiner is considered to be a new ground(s) of rejection. Further, there are other outstanding issues with the claims that have been noted and will be addressed once there has been an election to one of the groups of claims to be examined on the merits.

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Issue no. 3: Applicant Argues: All claims are believed to relate to a single invention and the restriction requirement is believed to be improper has been considered but is persuasive in part. Response: The Examiner has withdrawn the first Election/Restriction Requirement after consideration of the Applicant's arguments and a closer review of the claims. However, after the Examiner consulted with a more senior Examiner (a Primary Examiner) it was agreed there are two distinct inventions in the application. Claim 75 is a linking claim and has part of the limitations of claims 35-74, and 92-101. Claims 82-87 are distinctly different and constitute another invention because of their separate utility and recognized divergent subject matter.

Inquiries

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert

September 14, 2004